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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,210	09/15/2004	Makoto Kawamura	257909US6PCT	5092
22850	7590	06/29/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER KAMAL, SHAHID	
			ART UNIT 3621	PAPER NUMBER
			NOTIFICATION DATE 06/29/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/507,210	<b>Applicant(s)</b> KAWAMURA, MAKOTO	
	<b>Examiner</b> SHAHID KAMAL	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03/19/2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-6, 8-12, 14-19 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-12, 14-19, and 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/05/2009</u> .  | 6) <input type="checkbox"/> Other: _____                          |

***DETAILED ACTION***

***Acknowledgements***

1. Claims 1-6, 8-12, 14-19, and 21-25 are now pending in this application and have been examined.
2. Upon further review of the arguments provided by the applicant in the Appeal Brief filed 19 March 2009, the FINAL Office action mailed 21 August 2008 has been withdrawn. The prosecution of this application is hereby reopened.
3. The following is a NON-FINAL Office Action in response to the communication received on 19 March 2009.

***Priority***

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. The certify copy was filed on September 15, 2004.

***Information Disclosure Statement***

5. The Information Disclosure Statement filed on 05 June 2009 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-6, 8-12, 14-19 and 21-25 are rejected under 35 U.S.C. 102(e) as anticipated by Kambayashi et al. (US Patent No. 6,772,133 B1) (“Kambayashi”).

8. Referring to claim 1, Kambayashi discloses the following:

a) a license server (license server/fig.20) providing configured to provide a license (content ID/fig.3) for utilizing content (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11) ; and

b) a terminal configured to request the license (content ID/fig.3) from the license server (license server/fig.20), obtain the license (content ID/fig.3), and utilize the content based on the license (content ID/fig.3), wherein one of the license server (license server/fig.20) and the terminal includes: duplicate-license determination means for determining that the license (content ID/fig.3) requested by the terminal from the license server (license server/fig.20) is a duplicate of a license already held by the terminal (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5); and

c) wherein the terminal includes: license-duplication reporting means for reporting license (content ID/fig.3) duplication indicating that the license (content ID/fig.3) requested by the terminal from the license server (license server/fig.20) duplicates a license already held by the terminal according to the determination result by the duplicate-license determination means (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11).

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9. Referring to claim 2, Kambayashi discloses the following:

d) duplicate-license determination means for determining that the license requested from the license is a duplicate of an already available license (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5); and

e) license-duplication reporting means for reporting license duplication indicating that the license requested from the license server duplicates an already available license according to the determination result by the duplicate-license determination means (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

10. Referring to claim 3, Kambayashi discloses purchase-requesting means for requesting a purchase of the license from the license server according to an operation of a user, wherein the duplicate-license determination means determines whether or not the license to be purchased duplicates an already available license after or before the purchase- requesting means requests a purchase of the license from the license server (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

11. Referring to claim 4, Kambayashi discloses confirming means for confirming whether or not a license which duplicates an already available license is purchased when license duplication is reported by the license-duplication reporting means (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

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12. Referring to claim 5, Kambayashi discloses license-identification-information acquiring means for acquiring license identification information of a license required to utilize content from the license server (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11); and license-list storage means for storing a license list of licenses already purchased, wherein the duplicate-license determination means determines whether or not a license requested from the license server duplicates an already available license by comparing the license identification information acquired by the license-identification-information acquiring means with the license list stored by the license-list storage means (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

13. Referring to claim 6, Kambayashi discloses the following:

f) requesting a license from a license server providing the license for utilizing content (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5);

g) determining that the license requested from the license server is a duplicate of an already available license (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5); and

h) reporting license duplication indicating that the license requested from the license server duplicates an already available license according to the determination result in the determining step (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

14. Referring to claim 8, Kambayashi discloses the following:

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i) requesting a license from a license server providing the license for utilizing content (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5);

j) determining whether that the license requested from the license server duplicates an already available license (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5); and

k) reporting license duplication indicating that the license requested from the license server duplicates an already available license according to the determination result in the determining step (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11).

15. Referring to claim 9, Kambayashi discloses the following:

l) determination-result receiving means for receiving from the license server a result of determination that the license requested from the license server is a duplicate of an already available license (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5); and

m) license-duplication reporting means for reporting license duplication indicating that the license requested from the license server duplicates an already available license according to the result of determination as to license duplication received by the determination-result receiving means (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

16. Referring to claim 10, Kambayashi discloses confirming means for confirming whether or not a license which duplicates an already available license is purchased when license

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duplication is reported by the license-duplication reporting means (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

17. Referring to claim 11, Kambayashi discloses content-identification-information sending means for sending to the license server content identification information for identifying the content to be utilized, wherein the determination-result receiving means receives from the license server a result of determination as to whether or not the license required to utilize the content identified with the content identification information sent by the content-identification-information sending means duplicates an already available license (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

18. Referring to claim 12, Kambayashi discloses the following:

n) a determination-result receiving step of receiving from the license server a result of determination indicating that the license requested from the license is a duplicate of an already available license (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5); and

o) a license-duplication reporting step of reporting license duplication indicating that the license requested from the license server duplicates an already available license according to the result of determination as to license duplication received in the determination-result receiving step (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).



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19. Referring to claim 14, Kambayashi discloses the following:

p) requesting a license from a license server providing the license for utilizing content (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5);

q) receiving from the license server a result of determination indicating that the license requested from the license server is a duplicate of an already available license (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5); and

r) reporting license duplication indicating that the license requested from the license server duplicates an already available license according to the result of determination as to license duplication received in the receiving step (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

20. Referring to claim 15, Kambayashi discloses the following:

s) query means for making an inquiry about licenses already held by the terminal; duplicate-license determination means for determining that the license provided in response to the request by the terminal is a duplicate of a license already held by the terminal (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5); and

t) determination-result sending means for sending a result by the duplicate-license determination means indicating the duplication to the terminal (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

21. Referring to claim 16, Kambayashi discloses license-information storage means for storing information about the license provided to the terminal, wherein the query means asks the

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license-information storage means for licenses already held by the terminal (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

22. Referring to claim 17, Kambayashi discloses wherein the query means asks a management server managing information about the license provided to the terminal for licenses already held by the terminal (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

23. Referring to claim 18, Kambayashi discloses wherein, when the duplicate-license determination means determines that the license requested by the terminal duplicates a license already held by the terminal and when a message confirming purchase of the license that duplicates the license already held by the terminal is sent from the terminal, the license requested by the terminal is provided to the terminal (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

24. Referring to claim 19, Kambayashi discloses the following:

u) making an inquiry about licenses already held by the terminal (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5);

v) determining that the license provided in response to the request by the terminal is a duplicate of a license already held by the terminal (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5); and

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w) sending a result of the determining step indicating the duplication to the terminal (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

25. Referring to claim 21, Kambayashi discloses the following:

x) making an inquiry about licenses already held by the terminal (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5);

y) determining that the license provided in response to the request by the terminal is a duplicate of a license already held by the terminal (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5); and

z) sending a result in of the determining step indicating the duplication to the terminal (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

26. Referring to claim 22, Kambayashi discloses the following:

aa) a license server providing configured to provide a license for utilizing content (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5); and

bb) a terminal configured to request the license from the license server, obtain the license, and utilize the content based on the license, wherein one of the license server and the terminal includes: a duplicate-license determination section configured to determine that the license requested by the terminal from the license server is a duplicate of a license already held by the terminal (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5); and

cc) wherein the terminal includes: a license-duplication reporting section configured to report license duplication indicating that the license requested by the terminal from the license server duplicates a license already held by the terminal according to the determination result by the duplicate-license determination section (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

27. Referring to claim 23, Kambayashi discloses the following:

dd) a duplicate-license determination section configured to determine that a license requested from the license server is a duplicate of an already available license (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5); and

ee) a license-duplication reporting section configured to report license duplication indicating that the license requested from the license server duplicates an already available license according to the determination result by the duplicate-license determination section (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

28. Referring to claim 24, Kambayashi discloses the following:

ff) a determination-result receiving section configured to receive from the license server a result of determination that a license requested from the license server is a duplicate of an already available license (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5); and

gg) a license-duplication reporting section configured to report license duplication indicating that the license requested from the license server duplicates an already available license

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according to the result of determination as to license duplication received by the determination-result receiving section (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

29. Referring to claim 25, Kambayashi discloses the following:

hh) a query section configured to make an inquiry about licenses already held by the terminal (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11);

ii) a duplicate-license determination section configured to determine that the license provided in response to the request by the terminal is a duplicate of a license already held by the terminal (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5); and

jj) a determination-result sending section configured to send a determination result by the duplicate-license determination section indicating the duplication to the terminal (see abstract, figures 18-26, column 1, lines 14 through column 4, lines 11, column 26, claim 5).

30. Although Applicant(s) use “means for” in the claim(s) (e.g. claim 1-6, 8-12, and 14-16), it is the Examiner’s position that the “means for” phrase(s) do not invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. If Applicant(s) concur, the Examiner respectfully requests Applicant(s) to either amend the claim(s) to remove all instances of “means for” from the claim(s), or to explicitly state on the record why 35 U.S.C. 112 6<sup>th</sup> paragraph should not be invoked.

31. Alternatively, if Applicant(s) desire to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph, the Examiner respectfully requests Applicant(s) to expressly state their desire on the record. Upon receiving

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such express invocation of 35 U.S.C. 112 6<sup>th</sup> paragraph, the “means for” phrase(s) will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6¶*.<sup>1</sup>

32. Failure by Applicant(s) in their next response to also address the 35 U.S.C. 112 6<sup>th</sup> paragraph issues in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicant(s) NOT to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. Unless expressly noted otherwise by the Examiner, the preceding discussion on 35 U.S.C. 112 6<sup>th</sup> paragraph applies to all examined claims currently pending.

### ***Conclusion***

33. The prior art made of record and not relied upon is considered pertinent to applicant’s disclosure.

34. Any inquiry concerning this communication or earlier communications from the patent examiner should be directed to Shahid Kamal whose telephone number is (571) 270-3272. The Patent examiner can normally be reached on Monday-Thursday (8:30am -7:00pm), Friday off.

35. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for this origination where this application or proceeding is assigned is (571) 273-8300.

36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR.

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37. Statues information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-directed.uspto.gov>.

38. Should you have any questions on accessing to the Private PAIR system, contact the Electronic Business Center (EBC) at 1(866) 217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 1(800) 786-9199 (IN USA OR CANADA) or 1(571) 272-1000.

SK

June 20, 2009

/EVENS J. AUGUSTIN/

Primary Examiner, Art Unit 3621